

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: )  
Frank *et al.* )  
Serial No.: 09/750,001 ) Confirmation No.: 6605  
Filed: December 29, 2000 ) Group Art Unit: 3629  
For: System and Method for Marketing, ) Examiner: Ouellette, Jonathan P.  
Managing and Maintaining Intellectual ) Docket No.: 190252-1220  
Property )

**RESPONSE WITH AMENDMENTS**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicants submit this Response with Amendments for the Final Office Action mailed from the United States Patent and Trademark Office on May 7, 2007. In accordance with 37 C.F.R. § 1.114, a Request for Continued Examination is filed concurrently herewith to render non-final the above-referenced Final Office Action.

**Amendments to the Claims** begin on page 2 of this paper, in which claims 86 – 103 are amended, and claims 1 – 85 and 104 – 109 are cancelled.

**Remarks** begin on page 7 of this paper.

**AUTHORIZATION TO DEBIT ACCOUNT**

It is not believed that additional fees are required, beyond those that may otherwise be provided for in the documents accompanying this paper. However, in the event that additional fees are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor (including fees for net additions of claims) are hereby authorized to be charged to Deposit Account 20-0778.

## AMENDMENTS TO THE CLAIMS

Please make the following amendments to the claims:

1-85. (Cancelled)

86. (Currently Amended) A computer-readable medium containing a program for use with a computer for tracking innovation disclosures by an organization as part of a system for managing protection and licensing of intellectual property assets, the program comprising:

receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset, wherein the intellectual property asset protection data further includes data associated with a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators;

determining participation data for each of a plurality of innovator classes  
receiving disclosure gift information associated with each innovation  
disclosure of the plurality of innovation disclosures;

responsive to receiving the disclosure gift information associated with each  
innovation disclosure of the plurality of innovation disclosures,  
automatically updating an associated balance of stocked disclosure gifts;  
and

storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records.

87. (Currently Amended) The computer-readable medium of claim 86, wherein the program further comprises tracking and reporting costs associated with purchase of disclosure gifts plurality of innovator classes includes the class of employees of the organization.

88. (Currently Amended) The computer-readable medium of claim 86, wherein the program further comprises tracking and reporting information arranged by innovator regarding all disclosure gifts sent to each innovator of the plurality of innovators plurality of innovator classes includes the class of non-employees of the organization.

89. (Currently Amended) The computer-readable medium of claim 86, wherein the program further comprises automatically totaling numbers of disclosure gifts distributed within a time period plurality of innovator classes includes the class of contractors of the organization.

90. (Currently Amended) The computer-readable medium of claim 86, wherein the program further comprises: storing innovator data, the data including at least one of an employee/contractor status and a management/non-management status.

91. (Currently Amended) The computer-readable medium of claim 86, wherein the program further comprises: storing organization data associated with the innovator, the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.

92. (Currently Amended) An apparatus to track innovation disclosures by an organization as part of a system for managing protection and licensing of intellectual property assets, comprising:  
logic configured to receive intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights

pertaining to that intellectual property asset, wherein the intellectual property asset protection data further includes data associated with a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators;

logic configured to determine participation data for each of a plurality of innovator classes receive disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures;

logic configured to, responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, automatically update an associated balance of stocked disclosure gifts; and

logic configured to store the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records.

93. (Currently Amended) The apparatus of claim 92, further comprising logic configured to track and report costs associated with purchase of disclosure gifts wherein the plurality of innovator classes includes the class of employees of the organization.

94. (Currently Amended) The apparatus of claim 92, further comprising logic configured to track and report information arranged by innovator regarding all disclosure gifts sent to each innovator of the plurality of innovators wherein the plurality of innovator classes includes the class of non-employees of the organization.

95. (Currently Amended) The apparatus of claim 92, further comprising logic configured to automatically total numbers of disclosure gifts distributed within a time period wherein the plurality of innovator classes includes the class of contractors of the organization.

96. (Currently Amended) The apparatus of claim 92, further comprising[[::]] logic configured to store innovator data, the data including at least one of an employee/contractor status and a management/non-management status.

97. (Currently Amended) The apparatus of claim 92, further comprising[[.]] logic configured to store organization data associated with the innovator, the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.

98. (Currently Amended) A method for use with a computer for tracking innovation disclosures by an organization as part of a system for managing protection and licensing of intellectual property assets, comprising:

receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset, wherein the intellectual property asset protection data further includes data associated with a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators;

determining participation data for each of a plurality of innovator classes  
receiving disclosure gift information associated with each innovation  
disclosure of the plurality of innovation disclosures;

responsive to receiving the disclosure gift information associated with each  
innovation disclosure of the plurality of innovation disclosures,  
automatically updating an associated balance of stocked disclosure gifts;  
and

storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records.

99. (Currently Amended) The method of claim 98, further comprising tracking and reporting costs associated with purchase of disclosure gifts wherein the plurality of innovator classes includes the class of employees of the organization.

100. (Currently Amended) The method of claim 98, further comprising tracking and reporting information arranged by innovator regarding all disclosure gifts sent to each innovator of the plurality of innovators wherein the plurality of innovator classes includes the class of non-employees of the organization.

101. (Currently Amended) The method of claim 98, further comprising automatically totaling numbers of disclosure gifts distributed within a time period wherein the plurality of innovator classes includes the class of contractors of the organization.

102. (Currently Amended) The method of claim 98, further comprising[[:]] storing innovator data, the data including at least one of an employee/contractor status and a management/non-management status.

103. (Currently Amended) The method of claim 98, further comprising[[:]] storing organization data associated with the innovator, the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.

104 – 109. (Cancelled)

## **REMARKS**

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Final Office Action mailed May 7, 2007. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance. Claims 86 – 103 are amended, claims 1 – 85 and 104 – 109 are cancelled, and claims 86 – 103 are pending. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Examiner Interview**

Applicants first wish to express their sincere appreciation for the time that Examiner Ouellette spent with Applicants' Attorney, Jeffrey R. Kuester, during a telephonic interview on July 13, 2007. During that interview, the below-referenced new elements of the pending independent claims were generally discussed in view of U.S. Patent Number 6,298,327 ("Hunter"). While no agreement was reached during that interview, Applicants respectfully request careful consideration of this response.

### **II. Rejections Under 35 U.S.C. §§ 102(e) & 103**

The Office Action indicates that claims 86, 92, 98 and 107-109 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Number 6,298,327 ("Hunter"), and claims 87-91, 93-97, and 99-103 are rejected under 35 U.S.C. § 103 as being unpatentable over *Hunter*. Applicants respectfully traverse these rejections on the grounds that *Hunter* does not disclose, teach, or suggest all of the claimed elements.

In particular, Applicants note that all of the pending independent claims 86, 92 and 98 now substantially include the following elements, which Applicants submit *Hunter* does not disclose, "*receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, automatically updating an associated balance of stocked disclosure gifts.*" Support for such

elements can be found in the present specification, in accordance with one example, among others, on pages 182 – 197, and more specifically, on page 193.

Applicants submit that *Hunter* is completely devoid of any discussion of innovation disclosure gift information. Consequently, there is also no teaching in *Hunter* of automatically updating an associated balance of stocked disclosure gifts. As a result, Applicants submit that the presently pending claims 86 – 103 are clearly allowable over the art of record.

In addition, Applicants further submit that it would not be obvious to modify *Hunter* to include the above-referenced elements. Applicants contend that great synergy results from combining the claimed elements that would not be expected by one of ordinary skill in the art. In other words, Applicants respectfully submit that separate fields of endeavor are combined in a way that provides advantages not previously suggested or expected. For example, advantages are realized when scaling a large system for managing protection and licensing of intellectual property assets.

Furthermore, Applicants submit that improper hindsight reasoning should not be used to provide motivation for combining the receiving and storing of intellectual property asset protection data with the receiving of disclosure gift information and with responsively automatically updating an associated balance of stocked disclosure gifts. In essence, it is now established that a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning. Consequently, Applicants contend that the claimed combination would not be obvious to one of ordinary skill in the art.

## CONCLUSION

In conclusion, Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims be allowed to issue.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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& RISLEY, L.L.P.**

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